

Remarks

Claims 1-3 and 5-8 are under consideration. Claims 1-3, and 5-8 have been amended. Claims 4, and 9-11 have been cancelled. Reconsideration of claims 1-3 and 5-8 is respectfully requested. Applicants thank the examiner for her amendments in the claims.

Interview Summary

Rejection of Claims 1-8 of record were discussed as follows:

Claim 1: The informality in claim 1, the word “form” would be corrected.

Claim 2: The informality in claim 2, the phrase “C57BL/6J-Tyr^{C-23}” would be corrected.

Claim 3: The term “Chimeric” mouse would be amended to “transgenic” mouse. The “transgenic” will represent that foreign gene was introduced into mouse genome or endogenous gene was removed from mouse genome. Applicant would also submit data to demonstrate that germ line transmission is greatly improved in a black into black protocol. Data to demonstrate this would be submitted in a 1.132 Declaration.

Claim 4: The 103 rejection based on Schuster-Gossler, Smith and Katayama was maintained. Therefore, claim 4 is cancelled.

Claim 5: The 103 rejection based on Schuster-Gossler, Smith and Katayama would be overcome if an unexpected result was demonstrated. Applicants explained that when the invention uses albino B6 ES cells (new cell line of Claim 2) with C57BL/6 blastocysts, the efficiency of generating chimeras is improved over the conventional C57BL/6 ES cells with Balb/c or albino B6 blastocysts. Data to demonstrate this would be submitted in the 1.132 Declaration.

Claims 6-7: These are dependent on Claim 3. Amendment would be made in Claim 6 accordingly to change chimeric to transgenic. Claim 7 is in allowable form.

Claim 8: Claim is dependent on amended Claim 6 and is in allowable form.

35 U.S.C. § 112, first paragraph

The Action rejects claims 1 and 2 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement specifically in relation to the terms “c-23” in claim 2 and “B6” in claims 1, 2, 4, 5, 7, and 8.

In response, applicants have amended claim 2 to correct c-23 to c-2J.

35 U.S.C. § 112, second paragraph

Claims 1,2,3 and 6 were rejected under 35 U.S.C. 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention because claim 1 has a typographical “form” instead of “from”.

In response, claim 1 is amended to correct the informality.

Claim 2 is amended to clarify B6 ES cell line for C57BL/6J-Tyr^{c-2J}.

Claim 3 is amended to change “chimeric” to “transgenic”.

Therefore, based upon the above amendments the above rejections should be withdrawn.

Claim Rejections under 35 U.S.C. § 103

The Action rejected claims 3-8 under 35 U.S.C. 103 (a) as being unpatentable over Schuster-Gossler, et al (2001, BioTechniques, 31:1022-1026) and Smith (2001, Annu. Rev Cell Dev Biol 17: 435-462) in view of Katayama et al. (2001, Biochemical and Biophysical Research Communications 281: 1134-1140).

Applicants submit Exhibit 1, to demonstrate the differences between the 3 prior art references and present invention

In reference to claim 3, applicants have amended claim 3 to more specifically claim the transgenic mouse (and not a chimeric mouse). In addition, application have demonstrated unexpected results by introducing black C57 ES cells into black C57 blastocysts by demonstrating that the germline transmission is greatly improved. See Declaration of Dr. Wei He, paragraph 3.

Therefore, applicants respectfully request that this rejection be withdrawn.

Claim 4 is cancelled.

Claim 5 covers a combination of albino B6 ES cells into blastocysts from C57BL/6 mice. The results obtained were unexpected because the rate of generating chimeras with this combination was about two fold greater than that of B6 ES cells into albino blastocysts (like Schuster-Gossler). See Declaration of Dr. Wei He, paragraph 4. Therefore this rejection should be withdrawn.

Claims 7 and 8 are dependent on claims 3 and 6 claims respectively which have been amended. Therefore the rejection of claims 6-8 should be withdrawn.

Applicants are very grateful to Examiner Hama and Supervisory Patent Examiner, Dr. Ram Shukla, for granting the interview and for their assistance amending the claims and in resolving outstanding issues.

August 29, 2005.

Respectfully Submitted,

Rashida Karmali

Rashida A. Karmali, Esq.

Reg. No. 43,705

Attorney for Applicants

99 Wall Street, 10th Floor

New York, NY 10005

Phone (212) 651-9653

Fax (212) 651-9654

CERTIFICATE OF EXPRESS MAILING

I hereby certify that this correspondence is transmitted by Express Class No. ED
424855190 US under 37 C.F.R. 1.10 on August 29 2005, addressed to: Commissioner for
Patents, Alexandria, VA 22313-1450.

Rashida A. Karmali
Attorney for Applicants

Rashida Karmali

Signature
8/29/05